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Vincent Chan

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7590

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EXAMINER

CHU, CHRIS C

ART UNIT

PAPER NUMBER

2815

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/886,741

Applicant(s)

CHAN ET AL.

Examiner

Chris C. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 10, 14, 19, 22, 26, 42, 50, 52 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 - 9, 11 - 13, 16 - 18, 20, 23 - 25, 41, 44 - 48, 53, 54 and 56 - 61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are 2 - 14, 16 - 20, 22 - 26, 41, 42, 44 - 48, 50, 52 - 54 and 56 - 62.

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2005 has been entered. An action on the RCE follows.

### ***Response to Amendment***

2. Applicant's amendment filed on February 25, 2005 has been received and entered in the case.

### ***Election/Restrictions***

3. Applicant's election with traverse of Species III in the reply filed on 2/25/05 is acknowledged. The traversal is on the ground(s) that "since claims 10, 14, 19, 22 and 26 are all dependent from independent claims that are not restricted in this application, the independent claims do not cite evidence that are mutually exclusive from these dependent claims ... applicants request withdrawal of the restriction from at least claims 10, 14, 19, 22 and 26." This is not found persuasive because:

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- (a) The newly amended claim 7 contains the limitation “the unpackaged semiconductor die is wire bonded to the package module” which belongs in the Species I. Thus, the claim 7 is rejoined in the Species I.
- (b) Office action mailed on 6/18/04 established that the instant application has two Species. As explained in the above paragraph, the newly amended claim 7 is rejoined in Species I. Thus, Species I includes claims 2 - 9, 11 - 13, 16 - 18, 20, 23 - 25, 41, 44 - 48, 53, 54 and 56 - 60. and Species III includes claims 10, 14, 19, 22, 26, 42, 50 and 52.
- (c) Since the independent claims 56 – 59 are not generic claims. Claims 56 and 57 specifically state following limitation “**an unpackaged semiconductor die directly attached to the package module**, the unpackaged semiconductor die encapsulated onto the package module in a structure having a planar top surface” which is mutually exclusive from Species III in Fig. 9 of the instant application. Thus, the dependent claim 14 to the independent claim 59 and the dependent claim 26 to the independent claim 57 would NOT be rejoined.
- (d) Finally, if claims 14 and 26 were rejoined, it would create a 112 2<sup>nd</sup> issue because claims 57 and 59 (parents) are Species I while claims 14 and 26 are Species III.
- (e) For the above reasons, claims 10, 14, 19, 22, 26, 42, 50 and 52 would NOT be rejoined.
- (f) On page 10, the last paragraph, applicant argues “the restriction between Species I and III is untimely.” This argument is not found persuasive because the 37 CFR 1.142(a), second sentence states that the restriction may be made at any time

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before final action in the case at the discretion of the examiner. See 37 CFR

1.142(b) and MPEP § 811.

The requirement is still deemed proper and is therefore made FINAL.

4. Newly submitted claim 62 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim 62 is drawn to Species III, specifically, claim 62 recites the following sentence, “wherein the unpackaged semiconductor die is underfilled.” This belongs in Species III. However, the invention originally claimed does not have the above limitation to search in the Species I.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 62 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Double Patenting***

5. Claims 16 and 61 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 2 and 59. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

#### ***Claim Objections***

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6. Claims 7 and 59 are objected to because of the following informalities:

(A) In claim 7, the term “unpackaged semiconductors” lacks antecedent basis.

(B) In claim 59:

- On line 5, needs a comma, after term “the substrate”;
- On line 7, “cap wherein” should be --cap; and wherein--; and
- On line 7, “a planar” should be --the planar--.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 2, 5, 6, 8, 9, 12, 13, 16, 41, 44 – 48, 56 and 58 – 61 are rejected under 35

U.S.C. 102(e) as being anticipated by Lu et al. (U. S. Pat. No. 6,294,731).

Regarding claim 56, Lu et al. discloses in e.g., Fig. 1 and Fig. 7 a device comprising:

- a package module (a device in Fig. 7) including a substrate (150) having a standard package footprint;
- an unpackaged semiconductor die (the outermost device of the elements 110; column 7, line 28) directly attached to the package module (see Fig. 7), the unpackaged

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semiconductor die encapsulated (130 and 140; column 7, line 29) onto the package module in a structure having a planar top surface (see Fig. 7); and

- a packaged semiconductor die (the center device of the elements 110 which is packaged by element 140) having a top surface and attached to the package module;
- wherein the planar top surface of the encapsulated structure and the top surface of the packaged semiconductor die are of equal distance from the substrate (see Fig. 7).

Regarding claims 2 and 16, Lu et al. discloses in Fig. 7 the packaged semiconductor being packaged in a ball grid array package (column 7, lines 49 – 51).

Regarding claim 5, Lu et al. discloses a plurality of packaged semiconductors (the center device of the elements 110; column 7, lines 52 – 55) being attached to the package module.

Regarding claim 6, Lu et al. discloses in e.g., Fig. 7 the unpackaged semiconductor die (the outermost device of the elements 110) being wire bonded to the package module (see Fig. 7).

Regarding claim 8, the phrase “wherein attached includes surface-mount technology reflow” is product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). A “product by process” claim is directed to the product per se, no matter how actually made, In re Hirao, **190 USPQ 15 at 17** (footnote 3). See also In re Brown, **173 USPQ 685**; In re Luck, **177 USPQ 523**; In re Fessmann, **180 USPQ**



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**324:** In re Avery, **186 USPQ 116**; In re Wertheim, **191 USPQ 90** (**209 USPQ 254** does not deal with this issue); and In re Marosi et al., **218 USPQ 289** final product per se which must be determined in a “product by, all of” claim, and not the patentability of the process, and that an old or obvious product, whether claimed in “product by process” claims or not. Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear.

Regarding claim 9, Lu et al. discloses in e.g., Fig. 7 the encapsulated structure (the element that is encapsulated by the element 130) having a footprint greater than the footprint of the unpackaged semiconductor die (the outermost device of the elements 110).

Regarding claims 12, 48 and 60, since the element (140) of Lu et al. transfers a heat, the element 140 read as a heat sink (column 7, lines 54 – 55). Thus, Lu et al. discloses a planar heat sink adapted to engage the encapsulated structure and the top surface of the packaged semiconductor.

Regarding claim 13, Lu et al. discloses in e.g., Fig. 7 a top surface of the unpackaged semiconductor die and a top surface of the packaged semiconductor being of substantially equal distance from a surface of the package module.

Regarding claim 41, Lu et al. discloses in e.g., Fig. 7 the encapsulated semiconductor die forming a substantially rectangular structure on the package.

Regarding claim 58, Lu et al. discloses in e.g., Fig. 1 and Fig. 7 a multi-die module, comprising:

- a substrate (150) having a first surface and a second surface;

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- an unpackaged semiconductor die (the outermost device of the elements 110; column 7, line 28) mounted to the first surface of the substrate, the semiconductor die encapsulated (130 and 140) in a structure having a planar top surface; and
- a packaged semiconductor die (the center device of the elements 110 which is packaged by element 140) having a top surface and mounted on the first surface of the substrate;
- wherein the planar top surface of the encapsulated structure and the top surface of the packaged semiconductor die are of equal distance from the substrate (see Fig. 7).

Regarding claim 44, Lu et al. discloses further including a second packaged semiconductor die (the center device of the elements 110; column 7, lines 52 – 55) mounted on the first surface of the substrate.

Regarding claim 45, Lu et al. discloses in Fig. 7 a plurality of unpackaged semiconductor die mounted on the first surface of the substrate.

Regarding claim 46, Lu et al. discloses in e.g., Fig. 7 the unpackaged semiconductor die being mounted to the first surface of the substrate by wire bonding.

Regarding claim 47, Lu et al. discloses in e.g., Fig. 7 the encapsulating structure (130 and 140) being further comprised of an encapsulating material including epoxy, metal cap (140; column 7, line 55) or silicon coatings.

Regarding claims 59 and 61, Lu et al. discloses in e.g., Fig. 7 a multi-die module, comprising:

- a substrate (150) having a first surface;

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- an unpackaged semiconductor die (the outermost device of the elements 110; column 7, line 28) mounted to the first surface of the substrate, the semiconductor die encapsulated (130 and 140) in a structure having a planar top surface; and
- a packaged semiconductor die (the center device of the elements 110 which is packaged by element 140) having a top surface (claim 61) and mounted on the first surface of the substrate, wherein the encapsulating structure is further comprised of an encapsulating material of a metal cap (140); and
- wherein the planar top surface of the encapsulated structure and the top surface of the packaged semiconductor die are of equal distance from the substrate (see Fig. 7).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 4, 7, 17, 18, 20, 24, 25, 53, 54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu et al. in view of Hannah '232.

Regarding claims 3, 4, 53, 54 and 57, Lu et al. discloses in e.g., Fig. 7 a device comprising:

- a package module (a structure in Fig. 7);

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- a die (the outermost device of the elements 110) directly attached to the package module, the die encapsulated (130 and 140) on the package module in a structure having a planar top surface; and
- a packaged die (the center device of the elements 110 which is packaged by element 140) having a top surface and attached to the package module;
- wherein the planar top surface of the encapsulated structure and the top surface of the packaged die are of equal distance from the package module (see Fig. 7).

However, Lu et al. does not disclose the semiconductor dice being graphics-processor die and memory die. However, Hannah teaches in column 3, lines 42 - 46 and column 5, lines 16 - 21 semiconductor dice being a graphics-processor and a memory die. Thus, it would have been obvious to one of ordinary skill in the art at the time when the invention was made to modify Lu et al. by using the semiconductor die to be graphics-processor and memory as taught by Hannah. The ordinary artisan would have been motivated to modify Lu et al. in the manner described above for at least the purpose of receiving commands and graphics data from the main CPU of the computer (column 3, lines 42 - 46).

Regarding claim 7, Lu et al. discloses in e.g., Fig. 7 the unpackaged semiconductor die (the outermost device of the elements 110) being wire bonded to the package module (see Fig. 7).

Regarding claim 17, Lu et al., as modified, discloses a plurality of packaged memory (17) being attached to the package module.

Regarding claim 18, Lu et al., as modified, discloses directly attached including the graphics processing die (2) being wire bonded to the package module (see Fig. 7 of Lu et al.).

Regarding claim 20, the phrase “wherein attached includes surface-mount technology reflow” is product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based upon the product itself. The patentability of a product does not depend on its method of production. If the product in product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product is made by a different process. In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). A “product by process” claim is directed to the product per se, no matter how actually made, In re Hirao, **190 USPQ 15 at 17** (footnote 3). See also In re Brown, **173 USPQ 685**; In re Luck, **177 USPQ 523**; In re Fessmann, **180 USPQ 324**; In re Avery, **186 USPQ 116**; In re Wertheim, **191 USPQ 90** (**209 USPQ 254** does not deal with this issue); and In re Marosi et al., **218 USPQ 289** final product per se which must be determined in a “product by, all of” claim, and not the patentability of the process, and that an old or obvious product, whether claimed in “product by process” claims or not. Note that Applicant has the burden of proof in such cases, as the above caselaw makes clear.

Regarding claim 24, since the element (140) of Lu et al. transfers a heat, the element 140 read as a heat sink (column 7, lines 54 – 55). Thus, Lu et al. discloses a heat sink.

Regarding claim 25, Lu et al. discloses in e.g., Fig. 7 a top surface of the graphics-processor die and a top surface of the packaged memory being of substantially equal distance from a surface of the package module (see Fig. 7).

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lu et al. in view of Takano et al. ‘907.

Lu et al. discloses the semiconductor package set forth in the claims except for the standard package sizes being 40mm X 40mm. However, Takano et al. teaches in TABLE 1 a standard package sizes being 40mm X 40mm. Thus, it would have been obvious to one of ordinary skill in the art at the time when the invention was made to modify Lu et al. by using the standard package sizes as taught by Takano et al. The ordinary artisan would have been motivated to modify Lu et al. in the manner described above for at least the purpose of reducing a limitation in the size of a semiconductor chip (column 2, lines 6 and 7).

12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lu et al. and Hannah as applied to claim 57 above, and further in view of Takano et al.

Lu et al. and Hannah disclose the semiconductor package set forth in the claims except for the standard package sizes being 40mm X 40mm. However, Takano et al. teaches in TABLE 1 a standard package sizes being 40mm X 40mm. Thus, it would have been obvious to one of ordinary skill in the art at the time when the invention was made to further modify Lu et al. by using the standard package sizes as taught by Takano et al. The ordinary artisan would have been motivated to further modify Lu et al. in the manner described above for at least the purpose of reducing a limitation in the size of a semiconductor chip (column 2, lines 6 and 7).

#### ***Allowable Subject Matter***

13. The indicated allowability of claims 2 - 6, 8, 9, 11 - 13, 16 - 18, 20, 23 - 25, 41, 44 - 48, 53, 54 and 56 - 60 are withdrawn in view of the newly discovered reference(s) to Lu et al. Rejections based on the newly cited reference(s) follow.

*Response to Arguments*

14. Applicant's arguments with respect to claim 59 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris C. Chu whose telephone number is 571-272-1724. The examiner can normally be reached on 11:30 - 8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on 517-272-1664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chris C. Chu  
Examiner  
Art Unit 2815

c.c.  
Wednesday, March 02, 2005

  
GEORGE ECKERT  
PRIMARY EXAMINER